

REMARKS

This paper is in response to the Final Office Action mailed September 10, 2003. On the front page of the Final Office Action, the Examiner requested clarification of whether claims 17-27 were withdrawn or canceled. As they were drawn to a nonelected invention in light of the previous restriction requirement, the claims were withdrawn when election occurred. Applicant apologizes for any confusion on this matter.

New claims 28-38 particularly point out and distinctly claim subject matter regarded as the invention. Support for these claims may be found in the Specification, page 8, lines 19-29.

The First 35 U.S.C. § 103 Rejection

Claims 1-4, 6, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hirviniemi¹ in view of Richards², among which claims 1 and 6 are independent claims. This rejection is respectfully traversed.

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Hirviniemi, except that Hirviniemi does not teach that the emulation means is that of an "always connected" type.³ The Office Action further contends that Richards teaches means for emulation of an "always connected" type I/O device driver even though the communications are transmitted over a "connection establishment" type network and that it

¹ U.S. Patent 5,802,285

² U.S. Patent 4,853,954

³ Final Office Action, paragraph 6.

would be obvious to one having ordinary skill in the art at the time of the invention that incorporating Richards' modem with the protocol in Hirviniemi would have created a system which provides a transparent network connection in order to allow user applications to continue processing without waiting to be established. The Applicant respectfully disagrees for the reasons set forth below.

In response to the Office Action of June 2, 2003, Applicant responded that the stated motivation to combine the references was incorrect. The Patent Office apparently has misconstrued this argument. Applicant apologizes if the argument was less than clear, and will attempt to explain it in more detail here.

The Office Action of June 2, 2003 alleged that it would have been obvious to one of ordinary skill in the art to combine Richards with Hirviniemi to create a system which provides a transparent network connection in order to allow user applications to continue processing without waiting to be established. This, however, is not correct, as a combination of Richards with Hirviniemi would result in a system which provides a transparent network connection in order to allow host applications to continue processing without waiting to be established, as opposed to user applications. Therefore, the combination of Richards with Hirviniemi would not accomplish the same goal as the presently claimed invention, and thus not be useful for its intended purpose. While the Patent Office is correct in pointing out that there is no limitation in the claims specifically reciting allowing user applications to continue, the incorrectness of the stated motivation is relevant for two reasons.

The first is in relation to M.P.E.P. 2143.01, which discusses the requirement that there be a suggestion or motivation to modify the references. It states that "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Since the combination of the two prior art references would result in an invention that allows host applications to continue, but not user applications, and the intended purpose of the present invention is to allow user applications to continue, there is no motivation to combine the references and the rejection is improper.

The second reason the user-host distinction is important is because there is a limitation in the claims that simply cannot be taught by the combined references. The claims indicate that the emulation is of the operation of an "always connected" type I/O device driver *to the application software on the remote system*. Since, as stated above, the combined prior art references only provide emulation to a host application, it cannot teach or suggest emulation to the application software on a remote system.

Additionally, Applicant argued that Richards fails to teach emulating the operation of an "always connected" type I/O device driver to the application software on the remote computer system. Applicant argued that the structure in Richards (the modem being located on the host side) precluded the possibility that Richards even could teach emulating the operation of an "always connected" type I/O device driver to the application software on the remote computer.

As Applicant pointed out, "it would be impossible for the invention in Richards to do so because when the modem is offline, the user terminal *cannot* communicate at all with the modem."⁴

The Patent Office has apparently misconstrued this argument as it states that "the structure of Richards referred to by the applicant (the modem being located on the host side and not the user side), is not necessary for rejection to be proper."⁵ Applicant respectfully submits that in this case, the structure of the prior art is in fact very necessary for the rejection to be proper, because it precludes the prior art from teaching a claimed limitation. Namely, Richards simply cannot teach emulation of an "always connected" type I/O device driver to the application software on the remote computer as its structure precludes it.

Furthermore, the Final Office Action of September 10, 2003 states that "[w]ith regard to the claim that there is no teaching or suggestion to attempt to reply to communications from the user terminal with any sort of emulation (page 12, lines 14-15), Hirviniemi teaches a response to the user terminal ARP request to the MAC manager for a destination address (column 2, lines 11-24)."⁶ Applicant respectfully points out that the cited portion of applicant's response (page 12, lines 14-15) was referring to Richards and not Hirviniemi. Applicant discussed Hirviniemi's lack of teaching emulation of an "always connected" type I/O device in the Amendment filed

⁴ Amendment filed June 2, 2003, page 12.

⁵ Final Office Action, paragraph 3.

⁶ Final Office Action, paragraph 3.

March 14, 2003, and this argument was acknowledged and accepted as persuasive by the Patent Office in the Office Action of June 2, 2003.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Dependent Claims

The argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

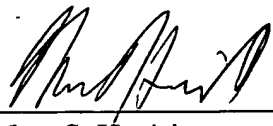
Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,
THELEN REID & PRIEST LLP

Dated: 3/5/04



Marc S. Hanish
Reg. No. 42,626

THELEN REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax (408) 287-8040